

Gates & Cooper LLP

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045

RECEIVED
CENTRAL FAX CENTER
MAY 02 2005

FAX TRANSMISSION TO USPTO

TO: Commissioner for Patents
Attn: Examiner Sanjiv Shah
Patent Examining Corps
Facsimile Center
Alexandria, VA 22313-1450

FROM: Jason S. Feldmar
OUR REF.: G&C 30566.86-US-01
TELEPHONE: (310) 642-4141

Total pages, including cover letter: 27

PTO FAX NUMBER: (703) 872-9306

If you do NOT receive all of the pages, please telephone us at (310) 641-8797, or fax us at (310) 641-8798.

Title of Document Transmitted:	BRIEF OF APPELLANT AND AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT IN THE AMOUNT OF \$500.00 FOR FILING FEE.
Applicant:	Jeffrey W. Small
Serial No.:	09/484,772
Filed:	January 18, 2000
Group Art Unit:	2176
Title:	MULTIPLE OUTPUT DEVICE ASSOCIATION
Our Ref. No.:	G&C 30566.86-US-01

Please charge all fees to Deposit Account No. 50-0494 of Gates & Cooper LLP

By: 

Name: Jason S. Feldmar
Reg. No.: 39,187

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.


Signature

5/2/05
Date

RECEIVED
MAY - 4 2005
OFFICE/USPTO

JSF/sjm

G&C 30566.86-US-01

Confirmation No.: 1090
Duc Date: May 2, 2005IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jeffrey W. Small	Examiner:	Sanjiv Shah
Serial No.:	09/484,772	Group Art Unit:	2176
Filed:	January 18, 2000	Docket:	G&C 30566.86-US-01
Title:	MULTIPLE OUTPUT DEVICE ASSOCIATION		

RECEIVED
CENTRAL FAX CENTER
MAY 02 2005

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on May 2, 2005.

By: 
Name: Jason S. Feldmar

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
- ☒ Brief of Appellant(s).
- ☒ Charge the Fee for the Brief of Appellant(s) in the amount of \$500.00 to the Deposit Account.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.

Please charge all fees to Deposit Account No. 50-0494 of Gates & Cooper LLP. A duplicate of this paper is enclosed.

Customer Number 22462GATES & COOPER LLPHoward Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045
(310) 641-8797By: Name: Jason S. Feldmar
Reg. No.: 39,187
JSF/sjm

G&C 30566.86-US-01

Confirmation No.: 1090
Due Date: May 2, 2005IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jeffrey W. Small	Examiner:	Sanjiv Shah
Serial No.:	09/484,772	Group Art Unit:	2176
Filed:	January 18, 2000	Docket:	G&C 30566.86-US-01
Title:	MULTIPLE OUTPUT DEVICE ASSOCIATION		

RECEIVED
CENTRAL FAX CENTER
MAY 02 2005

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on May 2, 2005.By: 
Name: Jason S. FeldmanMAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

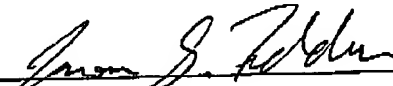
We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
- ☒ Brief of Appellant(s).
- ☒ Charge the Fee for the Brief of Appellant(s) in the amount of \$500.00 to the Deposit Account.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.

Please charge all fees to Deposit Account No. 50-0494 of Gates & Cooper LLP. A duplicate of this paper is enclosed.

Customer Number 22462
GATES & COOPER LLP
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045
(310) 641-8797

By: 
Name: Jason S. Feldman
Reg. No.: 39,187
JSF/sjm

G&C 30566.86-US-01

Due Date: May 2, 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Inventor: Jeffrey W. Small)	Examiner: Sanjiv Shah
)	
Serial #: 09/484,772)	Group Art Unit: 2176
)	
Filed: January 18, 2000)	Appeal No.: _____
)	
Title: <u>MULTIPLE OUTPUT DEVICE ASSOCIATION</u>)	

**RECEIVED
CENTRAL FAX CENTER
MAY 02 2005**

BRIEF OF APPELLANTS

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR §41.37, Appellants hereby submit the Appellants' Brief on Appeal from the final rejection in the above-identified application, as set forth in the Office Action dated December 3, 2004.

Please charge the amount of \$500.00 to cover the required fee for filing this Appeal Brief as set forth under 37 CFR §41.37(a)(2) and 37 CFR §41.20(b)(2) to Deposit Account No.50-0494 of Gates & Cooper LLP. Also, please charge any additional fees or credit any overpayments to Deposit Account No. 50-0494.

I. REAL PARTY IN INTEREST

The real party in interest is Autodesk, Inc., the assignee of the present application.

05/04/2005 CNGUYEN 00000042 500494 09484772

01 FC:1402 500.00 DA

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

III. STATUS OF CLAIMS

Claims 1-5, 7-15, 17-25, and 27-34 remain in the application.

Claims 6, 16, and 26 have been cancelled.

Claims 1-4 have been withdrawn from consideration based on a restriction requirement.

Claims 5, 7-15, 17-25, and 27-34 stand rejected.

The restriction requirement of claims 1-4 and the rejection of claims 5-7, 17-25, and 27-34 are being appealed.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

To utilize information stored on computers, users often need to output the information (e.g., to a printer). However, depending on the particular output device, the format of the same information may change (e.g., if a different printer is used that has different margins) (see page 1, lines 3-21). However, the prior art fails to provide a mechanism to associate a particular output device with a particular file or information (see page 1, line 22-page 2, line 6)

Appellants' invention, as recited in independent claims 5, 15, and 25, is generally directed to associating an output device configuration with information (see page 1, lines 5-8). More specifically, a file generated by a computer application is selected (see page 8, lines 8-10). An output device configuration is then selected (see page 8, lines 10-14). Thereafter, the selected output device configuration is associated with the file by saving an association between the output device configuration and the file with the file (see page 8, lines 14-17).

In view of the above, individual files/information have the capability to be associated with a particular output device configuration (see page 9, lines 16-19). When the file is retrieved or opened

again, the output device configuration associated with the file already exists and is associated with the file so no further configuration is necessary (see page 9, lines 19-22). Further, the user creating the file does not need to worry about how the document will print on a different printer/output device, since the user specifies which printer/output device the file/information is associated with and stores the association with the file itself.

Dependent claims 7, 17, and 27 provide that the information in the file is a drawing and the various steps of the claims are performed by a graphics program (see page 10, lines 1-17 and page 11, lines 5-23).

Dependent claims 8, 18, and 28 further depend on claims 8, 18, and 28 and provide that the information further comprises a layout of a drawing (see page 11, lines 5-23). As set forth in the specification, a layout provides a user interface for assisting a user in laying out drawings for printing and allow the user to easily compose a drawing and make it ready for hardcopy output. Such a layout gives the user an illusion of working on a "sheet" of paper with views into the model and provides visual clues that indicate the boundaries and margins (printable area) of the paper it will be printed/plotted on (see page 11, lines 5-23).

Dependent claims 9, 19, and 29 depend on the independent claims and provide for obtaining settings for an output device configuration. The settings are then associated with the information/file (see page 8, lines 14-17).

Dependent claims 10, 20, and 30 depend on claims 9, 19, and 29 and further provide that the associating of the settings is completed by saving the settings with the information (see page 8, lines 14-17).

Dependent claims 11, 21, and 31 depend on the independent claims and detail the steps involved for selecting the output device configuration. Specifically, a list of the output device configurations is retrieved. The list is displayed and the user selects one configuration from the list. (See page 45, lines 7-15).

Dependent claims 12, 22, and 32 also depend on the independent claims and provide that the output device configuration is for a printer. (See page 1, lines 11-21; page 3, lines 3-5).

Dependent claims 13, 23, and 33 depend on the independent claims and detail the selection of the output device configuration. In this regard, a configuration of "none" may be selected that

does not represent an installed output device. In such an instance, the claims provide for selecting an output device configuration that is similar to the "none" configuration (e.g., the settings specified by the user or a default). (See page 13, line 12 – page 15, line 8).

Dependent claims 14, 24, and 34 detail the associating aspects of the independent claims. Specifically, names of the various output device configurations are saved with the file (see page 17, line 4 – page 18, line 14).

In addition to the above currently pending claims, withdrawn claims 1-4 provide similar limitations.

Independent method claim 1 provides for associating multiple output devices with a drawing in a graphics program. Such a preamble is similar to dependent claims 7, 17, and 27 described above. The first step in claim 1 provides for selecting a first layout of a drawing. Drawing layouts are described above with respect to dependent claims 8, 18, and 28.

The second and third steps provide for select a first output device and first output device configuration. Independent claims 5, 15, and 25 (discussed above) provide for selecting an output device configuration (see page 1, lines 5-8).

The next step involves associating the first layout with the first output device and output device configuration. The discussion above with respect to independent claims 5, 15, and 25 provide for such an associating step (see page 8, lines 14-17).

The next 4 steps repeat the first four steps for a second output device and second output device configuration. In other words, claim 1 provides the ability to associate multiple output devices with a drawing. (see page 1, lines 1-5; page 1, lines 6-17; page 43, lines 9-12).

Dependent claim 2 provides that the output device and configuration selection steps are performed in a page setup dialog (see page 12, lines 9-13).

Dependent claim 3 provides for the output device and configuration selection steps are performed by scripting (see page 44, line 1).

Dependent claim 4 details the association step of independent claim 1. Specifically, names for the first and second output device are saved with the drawing, the first and second output device configurations are saved with the drawing, and first and second additional configuration information are saved with the first and second output device respectively (see page 44, line 13 – 46, line 3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4 stand withdrawn as having being directed towards an invention distinct from claims 5-34.

Claims 5-10, 12, 14-20, 22, 24-30, 32, and 34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Snyders, U.S. Patent No. 5,982,996 (Snyders).

Claims 11, 13, 21, 23, 31, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Snyders in view of Marbry et al., U.S. Patent No. 5,692,111 (Marbry).

VII. ARGUMENTS

A. The Restriction Requirement is Improper

In the Office Action mailed February 24, 2004, a restriction requirement established two inventive groups stating that the two following inventions were distinct:

I. Claims 1-4, drawn to a method of associating multiple output device with a drawings in a graphics program, classified in class 715, subclass 517.

II. Claims 5-34, drawn to a method of associating output device configuration, classified in class 715, subclass 525.

Appellants elected group II with traverse. Appellants Appeal the restriction requirement herein.

Appellants note that claim 1 specifically identifies output device configurations. Further, claim 1 provides for associating a layout with an output device and an output device configuration. Accordingly, claim 1 is directed towards associating multiple output device configurations. Additionally, claim 5 is directed towards output device configurations. It may be understood that multiple output device configurations can be for multiple output devices. For example, claim 12 states that one of the output device configurations is for a printer – a particular type of output device. In this regard, other output device configurations may be directed towards other output devices. Accordingly, both Inventions identified in the restriction requirement are directed to common subject matter.

Appellant also notes the subject matter of each of the claim Groups is linked by a common inventive concept. According to M.P.E.P. §803, there are two criteria for a proper restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met. The common elements of output device configurations and the output devices indicate a common inventive concept such that there would not be a serious burden on the Examiner. Appellant asserts that a search into prior art with regard to the invention of the different Groups is so related that separate significant search efforts should not be necessary. Accordingly, there is no serious burden on the Examiner to collectively examine the different claim Groups of the subject application. Therefore, restriction is not proper under M.P.E.P. §803.

In response to the above arguments (submitted in response to the restriction requirement), the Examiner asserted that Group I claims subject matter to associate different layout of drawings to different output device, that is to associate different portion of file to different output device whereas Group II claims subject matter to configure an output device.

Appellant respectfully disagrees. As set forth in the claims, Group I is configured to associate different files or different layouts of files with different output devices. However, Group II is not claiming how to configure an output device. As claimed, Group II is directed towards associating multiple output device configurations with information such as a file (e.g., a drawing file). In this regard, the claims are not directed towards configuring the output devices themselves. In fact, claim 8 which is in Group II specifies that the information that is associated with an output configuration is a layout of a drawing - which is similar to that claimed in Group I.

In response to the above arguments (submitted in response to the first Office Action), the Patent Office merely repeated verbatim the prior response. Appellant reasserts the above arguments. In addition and in view of the above, Appellants also assert that independent claim 1 provides specifically for two output devices and configurations whereas independent claim 5 provides for one or more output device configurations. In view of the clear similarities between the claims and the context in which they are used, Appellants assert that the restriction requirement is improper, that no separate search would be required, that there is no additional burden on the

Examiner to search different inventions, and respectfully request the Board reverse the restriction requirement.

B. The Independent Claims Are Patentable Over The Prior Art

The Examiner states

Regarding claims 5, 15, and 25, Snyders teaches the claimed invention of associating multiple output device as shown in Fig. 1.

A computer with information (shown in Fig. 1, element 10) comprising a file generated by computer application (col. 2, lines 12-14).

One or more printer (output device) configuration stored is shown in Fig. 9, element 57,24. Also see col. 2, lines 38-49.

Selecting information is shown in Fig. 7, element 53 and 56.

Selecting one or more output device configuration is shown in Fig. 7, element 57 and col. 2, lines 38-49.

Associating information with output device configuration (shown in Fig. 10, element 57,26) by saving an association between selected information and output device configuration with the file (see col. 2, lines 28-49, wherein Snyders teaches generating a output file and retrieving one or more printer configuration and providing the file to a output file and retrieving one or more printer configuration and providing the file to prior processor, retrieving printer configuration, retrieving printer document properties, (i.e. file properties with the printer properties that is equivalent to claimed association saved in memory) saving the new properties in the registry).

Appellant traverses the rejections for one or more of the following reasons:

- (1) Neither Snyders nor Marbry teach, disclose or suggest associating an output device configuration with a particular file of information that is generated by a computer application; and
- (2) Neither Snyders nor Marbry teach, disclose or suggest saving an output device configuration with a particular file generated by a computer application.

As described above, independent claims 5, 15, and 25 are generally directed to associating an output device configuration with information. More specifically, a file/information that is generated by a computer application is selected. Further, an output device configuration is selected. Thereafter, the selected output device configuration is associated with the information/file by saving the association between the output device configuration and the file/information with the file/information. Thus, individual files/information have the capability to be associated with a particular output device configuration. When the file is retrieved or opened again, the output device configuration associated with the file already exists and is associated with the file so no further configuration is necessary. Further, the user creating the file does not need to worry about how the document will print on a different printer/output device, since the user specifies which printer/output device the file/information is associated with and stores the association with the file itself.

The cited references do not teach nor suggest these various elements of Appellant's independent claims.

Snyders merely describes the ability to print a single file on multiple output devices (see Abstract; col. 1, lines 9-13; col. 7, lines 46-55). However, there is no capability or description, implicit or explicit, for associating the configuration with the file or saving an association (between an output device configuration and the file) with the file.

In rejecting the associating step of the present invention, the Office Action relied on fig. 10, element S7.26. Fig. 10, S7.26 provides for "changing document properties to match new driver settings". In this regard, element S7.26 (as described in col. 12, lines 24-31) merely provides that upon selecting a particular printer, the document is updated with the properties for that printer. Such a teaching is consistent with the problems of the prior art set forth in the specification of the present invention. Namely, when the new printer is selected, the document format may change to accommodate the new printer. The present claims further elaborate on the association by stating that the association itself is stored/saved with the file/information. There is no such mechanism in Snyder or the other cited art.

The final Office Action rejected the saving of the association aspects of the claim based on col. 2, lines 28-49 of Snyder stating:

Snyders teaches generating an output file and retrieving one or more printer configuration and providing the file to print processor, retrieving printer configuration, retrieving printer document properties, (i.e., file properties with the printer properties that is equivalent to claimed association saved in memory) saving the new properties in the registry).

Col. 2, lines 25-49 of Snyders provides:

According to another aspect of this invention, the information distributing apparatus depicted generally in FIGS. 1-5 implements a method for operating within a computer network environment. The method is implemented in a system for distributing print jobs from a computer usable for operating in a computer network environment of the type having an operating system; an application configured for running on the operating system and generating a source job comprising an output instruction file; and at least one output device having an output device driver for receiving the output instruction file for producing output. The method includes the steps of: providing a print processor in the form of an intermediate executable for operating on the output instruction file; retrieving printer details for an identified printer driver name from a memory location in a memory of the computer; changing the printer driver name in the memory to a different driver of a different printer; saving the printer details of the identified printer driver name in the form of new printer information in a system registry; retrieving printer document properties of the saved printer details from memory; changing the retrieved printer document properties to match new driver settings; saving the new printer document properties in the system registry; and allocating and initializing print processor data structures usable to execute a print job on the new printer.

As can be seen from this text, Snyders merely provides for various printer drivers having different names and different information. In addition, the printer drivers are stored in the system registry. One needs to attempt to map the different elements of Snyders to the present claims. The Office Action states that Snyders' "file properties with printer properties" is equivalent to the claimed association saved in memory. Appellants submit that Snyder fails to teach any "file properties with printer properties". The quoted text does not reference "file properties". In fact, an electronic search of Snyders for the term "file properties" provides no results. In addition, an electronic search of Snyders for the term "printer properties" also yields no results.

Again, Snyders first teaches the generation of a source job that is an output instruction file (see col. 2, lines 28-33). An output device having a device driver receives the output instruction file and produces an output (see col. 2, lines 32-35).

The text then describes the details for how the output is produced. A print processor operates on the output instruction file. Printer details are retrieved from a printer driver and the name of the printer driver is changed and saved into the system registry. Printer document properties OF the saved printer details are retrieved, changed, and saved again in the system registry. Thereafter, print processor data structures are allocated and initialed in order to execute a print job on the new printer.

Such a teaching is not even remotely equivalent to the present invention.

The first claimed element is for selecting information that is a file. The system registry is not a file. Instead, a registry is known in the art as being a configuration database that contains settings for hardware and software in the PC it is installed in. Such a system registry is not equivalent to a file or a file that has been generated by a computer application.

Accordingly, Snyders' system registry is not equivalent to the claimed file that is generated by a computer application. Thereafter, an output device configuration is selected. Snyders' various printer drivers could potentially be viewed as similar to the output device configuration set forth in the independent claims.

The next step in the claims is for associating the information/file with the output device configuration. This claimed step saves "an association" between the selected file and the output device configurations with the file itself. Thus, an actual association between two items (i.e., the file

and one or more output device configurations) is stored. There is no such equivalent storing anywhere in Snyders. Instead, Snyder provides for retrieving printer document properties from the system registry and saving changes in the system registry. Thus, instead of storing an association with a particular printer/output device configuration with a file, Snyders merely makes changes to an output device configuration stored in a system registry and saves the changes in the system registry. Again, there is no way to map the claimed elements to that set forth in Snyders. Nor does Snyder teach, disclose, or suggest, implicitly or explicitly, the sequence of elements set forth in the claims.

In response to arguments similar to the above, the final Office Action provides:

As clearly cited in the office action, Snyder does teach association being saved as cited in col. 2, lines 28-49. The claimed invention does not specify association contents. Therefore the broadest reasonable interpretation of saving association is that both the files (output file from application and configuration file from the printer) are saved. Applicant further argues that saving step is different from registry saving because registry is not a file. Examiner disagrees. Information or data is always saved in memory or registry device. File itself have to be stored in memory or registry. Therefore the arguments that the information is not stored in file are not persuasive. Also as described in col. 2, lines 28-49, Snyders does teach saving the output file with configuration information in the memory. It is inherent that the data is stored in a file in a memory. Therefore applicant's arguments are not persuasive.

As stated above, col. 2, lines 28-49 does not teach saving the association. Appellants also disagree with the Examiner's statement that the claimed invention does not specify association contents. The claims specifically set forth: "associating said information with said one or more output device configurations by saving an association between said selected information and said one or more selected output device configurations with said file." Further, the claims provide that the selected information is the file generated by a computer application. Accordingly, the claims explicitly provide that the association is between a file generated by a computer application and one or more selected output device configurations. In addition, the "association" is actually saved with the file generated by the computer application. Accordingly, the same file that is generated by a computer application contains an association with a particular output device configuration. For example, a drawing generated by a graphics program contains an association with a particular output device configuration.

The response from the Patent Office states that the broadest reasonable interpretation merely provides that the output file from the application and the configuration file from the printer are saved. However, merely saving two files in two separate locations is not what the claims provide

for. Instead, the claims provide for associating a particular file with a specific output device configuration and then saving the association between the two with the file itself. Accordingly, merely saving an output file from an application and a configuration file from a printer does not even remotely read or render obvious the present claims.

Appellants also note that the Patent Office appears confused as to the teaching of Snyders. The first portion of col. 2, lines 25-49 describes the system that the method is implemented on. Namely, an application generates an output instruction file and an output device having an output device driver (that can receive the output instruction file and produce an output) (see col. 2, lines 28-35). The second portion of col. 2, lines 25-49 provide details of the actual method itself that executes on the aforementioned system. In this regard, the second portion of the paragraph describes the following steps performed by a print processor (that can operate on the output instruction file):

- retrieve printer details for a driver name (in the memory of the computer);
- change the printer driver name;
- save the printer details for the new name in a system registry;
- retrieve printer document properties of the saved printer details from memory;
- change the printer document properties to match the new driver settings;
- save the new printer document properties in the system registry; and
- allocate and initialize print processor data structures that can be used to execute a print job on the new printer.

Such a sequence of steps does not read on the presently claimed invention. The preceding paragraph in Snyders describes how Snyders' invention works (see col. 2, lines 5-24). Namely, there an application on a computer generates a source job in the form of an output instruction file. The output instruction file is fed to an output device driver (i.e., for an output device) that converts the output instruction file to output instructions usable by the output device to produce output. Reading this portion of Snyders with the cited paragraph clearly shows a series of tasks distinctly different from the presently claimed invention. In this regard, the particular claimed association between a file and an output device configuration is not saved with a file itself. Nowhere in Snyders is there even a remote implication of such a capability.

The final Office Action continues and disputes that there is a difference between a system registry and a file. As stated in the Office Action, a file is often saved in memory. However, a file may not be saved in a registry device. As known in the art, a registry is used to a configuration database used to store configuration information for hardware and software of the computer itself and is not used to store a file. Snyders' printer information is for hardware and is stored in a system registry and not a file.

In view of the above, Appellants assert that the rejection of the independent claims fails to establish a prima facie case of non-obviousness or lack of novelty and respectfully requests reversal of the rejections.

C. Dependent Claims 7, 17, and 27 are Patentable Over the Cited Art

Dependent claims 7, 17, and 27 provide that the information in the file is a drawing and the various steps of the claims are performed by a graphics program (see page 10, lines 1-17 and page 11, lines 5-23).

Thus, not only do these claims specifically provide that the file is a drawing generated by a graphics program, but the claims provide that the association between the drawing and a selected output device configuration is saved with the drawing file. Snyders completely fails, explicitly or implicitly, to teach, describe, or suggest such an invention.

In rejecting these claims, the Office Action merely states that the information to be printed is a graphics or drawing file as shown by fig. 7, element S3. Appellants respectfully disagree. Element S3 merely provides "GDI GENERATES DATA IN INTERMEDIATE DRAWING INSTRUCTIONS (ENHANCED META FILE)". Nowhere in this text or the description of the figures in col. 10, lines 56-63 is there a remote reference to a drawing, drawing file, or a graphics program. In this regard, merely generating data in intermediate drawing instructions does teach, disclose, or remotely allude to storing an association with a selected output device configuration with a drawing. Again, intermediate drawing instructions (that is a meta file) is not a drawing or drawing file as claimed.

In view of the above, Appellants respectfully request reversal of the rejection of these claims.

D. Dependent Claims 8, 18, and 28 are Patentable Over the Cited Art

Dependent claims 8, 18, and 28 further depend on claims 8, 18, and 28 and provide that the information further comprises a layout of a drawing (see page 11, lines 5-23). As set forth in the specification, a layout provides a user interface for assisting a user in laying out drawings for printing and allow the user to easily compose a drawing and make it ready for hardcopy output. Such a layout gives the user an illusion of working on a "sheet" of paper with views into the model and provides visual clues that indicate the boundaries and margins (printable area) of the paper it will be printed/plotted on (see page 11, lines 5-23).

The rejection of these claims were grouped with claims 7, 17, and 27 and again merely recited fig. 7, element S3. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." The rejection merely ignores the claim limitations relating to the layout of the drawing. In this regard, an electronic search of Snyders for the term "layout" merely produces a single result in the brief description of the drawings that provides "Fig. 1 ...depicting one layout of a plurality of computers and output devices..." (see col. 2, lines 56-62). Without even mentioning the word layout with respect to a drawing program or a layout of a drawing, Snyders cannot possibly teach or render these claims as lacking novelty.

In view of the above, Appellants respectfully request reversal of the rejection of these dependent claims.

E. Dependent Claims 9, 19, and 29 are Not Separately Argued

F. Dependent Claims 10, 20, and 30 are Patentable Over the Cited Art

Dependent claims 10, 20, and 30 depend on claims 9, 19, and 29 and further provide that the associating of the settings is completed by saving the settings with the information (see page 8, lines 14-17).

Thus, these dependent claims provide for a saving step (saving settings for the output device configuration with the file/information). In rejecting this claim, the Office Action relied on Fig. 9, element S7.24. Element S7.24 provides "save new printer info in the system registry". In other words, the new printer info is saved in the system registry, which is a registry of system information. In this regard, the system registry is not the same as the file/information that has been associated with the output device (see discussion above). The system registry is not a file and is not information that is associated with a particular output device configuration. Additionally, the system registry is not selected as in the present claims. Accordingly, Snyder does not provide, describe, teach, disclose, suggest, or allude to, implicitly or explicitly, a file that is saved with an association to an output device configuration. Further, Snyder completely fails to even remotely suggest saving such an association between a particular file/information (that is created by a computer application) with an output device configuration.

In view of the above, Appellants respectfully request reversal of these rejections.

G. Dependent Claims 11, 21, and 31 are Patentable Over the Cited Art

Dependent claims 11, 21, and 31 depend on the independent claims and detail the steps involved for selecting the output device configuration. Specifically, a list of the output device configurations is retrieved. The list is displayed and the user selects one configuration from the list. (See page 45, lines 7-15).

In rejecting these claims, the final Office Action admits that Snyders fail to teach the claimed elements. Instead, the Office Action relies on Marbry.

Firstly, Appellants note that the context in which the presentation of the list of output device configurations is used is important to the claims. In this regard, the list is displayed so that a particular output device configuration may be selected and then associated with a particular file where the association is saved. Marbry fails to teach such a context. Marbry solely relates to the ability to allow a user to print to any printer available within a distributed system by selecting a printer and requesting to print on the printer (see Abstract). Marbry completely fails to provide any ability to associate a selected printer with a particular file. Marbry merely provides the ability to select from among a list of printers.

The sequence of events in the current claims are closely related and rely on each other. In this regard, the selection of the printer from the list of printers as claimed is used in the associating step. Such a unique sequence of events cannot be extracted and taken out of context as the rejection has done when combining Marbry with Snyders.

In view of the above, Appellants respectfully request reversal of the rejections.

H. Dependent Claims 12, 22, and 32 are Not Separately Argued

I. Dependent Claims 13, 23, and 33 are Patentable Over the Cited Art

Dependent claims 13, 23, and 33 depend on the independent claims and detail the selection of the output device configuration. In this regard, a configuration of "none" may be selected that does not represent an installed output device. In such an instance, the claims provide for selecting an output device configuration that is similar to the "none" configuration (e.g., the settings specified by the user or a default). (See page 13, line 12 – page 15, line 8).

Appellants note that the claims provide for the use of the word "none" in quotes. Further, the claims provide for selecting a configuration similar to a "none" configuration.

In rejecting these claims, the final Office Action relies on col. 3, lines 25-30 of Marbry. These lines of Marbry merely provide that difficulty arises when a user requests to print a document on a printer in a network for which the configuration information and printer driver are not locally installed. In such a situation, Marbry specifically provides for "copying the requisite configuration information and printer driver to a location that is accessible to the workstation so that the workstation may access the printer configuration data and printer driver to print the document on the remote printer." (see col. 3, lines 29-35). Such a teaching does not select an output device configuration similar to the "none" configuration as claimed. Instead, Marbry teaches away from such an implementation by teaching to transfer the configuration information for the not-installed printer to a locally accessible location.

Again, instead of selecting a similar configuration, Marbry teaches for using the exact same configuration by installing the appropriate information. Such a teaching is in direct contradiction to the claim language. Accordingly, Appellants respectfully request reversal of the rejections.

J. Dependent Claims 14, 24, and 34 are Not Separately Argued

VIII. CONCLUSION

In light of the above arguments, Appellants respectfully submit that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellants' claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

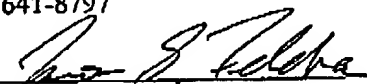
Respectfully submitted,

GATES & COOPER LLP

Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: May 2, 2005

By: 
Name: Jason S. Feldman
Reg. No.: 39,187

JSF/bjs/sjm

G&C 30566.86-US-01

APPENDIX

1. (WITHDRAWN) A computer implemented method for associating multiple output devices with a drawing in a computer-implemented graphics program comprising:
 - selecting a first layout of said drawing;
 - selecting a first output device;
 - selecting a first output device configuration;
 - associating said first layout with said first output device and said first output device configuration;
 - selecting a second layout of said drawing;
 - selecting a second output device;
 - selecting a second output device configuration;
 - associating said second layout with said second output device and said second output device configuration.
2. (WITHDRAWN) The method of claim 1 wherein said first and second output device selection steps and said first and second output device configuration steps are performed in a page setup dialog.
3. (WITHDRAWN) The method of claim 1 wherein said first and second output device selection steps and said first and second output device configuration steps are performed by scripting.

4. (WITHDRAWN) The method of claim 1 wherein said association steps comprise:
- saving a name for said first output device with said drawing;
 - saving a name for said second output device with said drawing;
 - saving said first output device configuration with said drawing;
 - saving said second output device configuration with said drawing;
 - saving first additional configuration information with said first output device; and
 - saving second additional configuration information with said second output device.
5. A computer-implemented method for associating multiple output device configurations with information comprising:
- selecting information comprising a file generated by a computer application;
 - selecting one or more output device configurations; and
 - associating said information with said one or more output device configurations by saving an association between said selected information and said one or more selected output device configurations with said file.
6. (CANCELED)
7. The method of claim 5 wherein said steps are performed in a computer-implemented graphics program and said information comprises a drawing.
8. The method of claim 7 wherein said information further comprises a layout of said drawing.

9. The method of claim 5 further comprising:
obtaining settings for at least one of said output device configurations; and
associating said settings with said information.
10. The method of claim 9 wherein said associating said settings step comprises saving
said settings with said information.
11. The method of claim 5 wherein said selecting one or more output device
configurations comprises:
retrieving a list of output device configurations;
displaying said list of output device configurations; and
selecting at least one output device configuration from said list of output device
configurations.
12. The method of claim 5 wherein at least one of said output device configurations is
for a printer.
13. The method of claim 5 wherein selecting an output device configuration comprises
selecting a "none" configuration that does not represent an installed output device, said method
further comprising selecting an output device configuration that is similar to the "none"
configuration.

14. The method of claim 5 wherein said associating step comprises saving names of said one or more selected output device configurations with said information.

15. A system for associating multiple output device configurations with information comprising:

a computer;

means, performed by the computer, for creating a file of information;

means, performed by the computer, for storing said created file of information on said computer;

one or more output device configurations stored on said computer;

means, performed by the computer, for selecting one or more of said one or more output device configurations; and

means, performed by the computer, for associating said information with said one or more selected output device configurations by storing an association between said information and said one or more selected output device configurations with said file.

16. (CANCELED)

17. The system of claim 15 implemented in a computer-implemented graphics program and said information comprises a drawing.

18. The system of claim 17 wherein said information further comprises a layout of said drawing.

19. The system of claim 15 further comprising:
means, performed by the computer, for obtaining settings for at least one of said output devices; and
means, performed by the computer, for associating said settings with said information.

20. The system of claim 19 wherein said means for associating comprises means for saving said settings with said information.

21. The system of claim 15 wherein said means for selecting said one or more output device configurations comprises:

means, performed by said computer, for retrieving a list of said one or more output device configurations;

means, performed by said computer, for displaying said list of said one or more output device configurations; and

means, performed by a user of said computer, for selecting at least one of said output device configurations from said list of one or more output device configurations.

22. The system of claim 15 wherein at least one of said output device configurations is for a printer.

23. The system of claim 15 wherein the means for selecting an output device configuration comprises means for selecting a "none" configuration that does not represent an installed output device, said system further comprising means for selecting an output device configuration that is similar to the "none" configuration.

24. The system of claim 15 wherein said means for associating comprises means, performed by said computer, for saving names of said one or more selected references with said information.

25. An article of manufacture embodying logic for performing a method for associating multiple output device configurations with information, the method comprising:
selecting information comprising a file generated by a computer application;
selecting one or more output device configurations; and
associating said information with said one or more output device configurations by saving an association between said selected information and said selected one or more output device configurations with said file.

26. (CANCELED)

27. The article of manufacture of claim 25 wherein said method is performed in a computer-implemented graphics program and said information comprises a drawing.

28. The article of manufacture of claim 27 wherein said information further comprises a layout of said drawing.

29. The article of manufacture of claim 25, said method further comprising:
obtaining settings for at least one of said output device configurations; and
associating said settings with said information.

30. The article of manufacture of claim 30 wherein said associating said settings comprises saving said settings with said information.

31. The article of manufacture of claim 25 wherein said selecting one or more output device configurations comprises:

retrieving a list of output device configurations;
displaying said list of output device configurations; and
selecting at least one output device configuration from said list of output device configurations.

32. The article of manufacture of claim 25 wherein at least one of said output device configurations is for a printer.

33. The article of manufacture of claim 25 wherein said selecting an output device configuration comprises selecting a "none" configuration that does not represent an installed output

device, said method of said article of manufacture further comprising selecting an output device configuration that is similar to the "none" configuration.

34. The article of manufacture of claim 25 wherein said associating comprises saving names of said one or more selected output device configurations with said information.